1631

Patent
Docket No.:53091USA8A.009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#6 Plunkett 4/13/01

In re Application of:
Ai-Ping Wei and Michael G. Williams

Serial No.: **09/448,633**
Filed: November 24, 1999
For: FLUOROGENIC PROTEASE SUBSTRATES BASED ON DYE-DIMERIZATION

Group Art Unit: 1631
Examiner: M. Moran

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This response is to the Office Action mailed March 26, 2001. Claims 1-21 have been restricted under 35 U.S.C. § 121 as follows:

I. Claims 1-11 and 21 are said to be drawn to methods of biological assay and detection of a microorganism, classified in Class 435, subclass 24; and

II. Claims 12-20 are said to be drawn to a protease substrate, classified in Class 530, subclass 300.

Applicants hereby elect Group II (i.e., claims 12 – 20) with traverse, and respectfully request reconsideration and withdrawal or modification of the restriction requirement.

The Restriction Requirement (Paper No. 5 states:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using the product (MPEP § 806.05(h)). In the instant case the peptide

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Date: April 6, 2001	Signature Melanie Gover

product of Group II may be used in various assay methods such as ELISAs, Westerns, etc. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and because the search for the product of Group II does not require a search for the method steps of Group I, restriction for examination purposes as indicated is proper.

Applicants submit the Groups I and II claims are so interrelated that a search of one group of claims will reveal art to the other. Moreover, the classification of Groups I and II claims in different classes and subclasses is not sufficient grounds to require restriction.

Were restriction to be effected between the claims in Groups I and II, a separate examination of the claims in Groups I and II would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I and II would have to be as rigorous as when only the claims of Group I were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicants submit that for restriction to be effected between the claims in Groups I and II, it would place an undue burden by requiring payment of a separate filing fee for examination of the nonelected claims, as well as the added costs associated with prosecuting two applications and maintaining two patents.

Based on the foregoing, Applicant requests that the Examiner reconsider and withdraw the restriction requirement.

Respectfully submitted,

Registration Number	Telephone Number
41,793	651-736-6432
Date April 6, 2001	

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